PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Akira MIZUTA

Docket No: Q76402

Appln. No.: 10/648,280

Group Art Unit: 1772

Confirmation No.: 4443

Examiner: Patricia L. Nordmeyer

Filed: August 27, 2003

For: COVER SHEET PACKAGE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated March 16, 2006, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Status of the Application

Claims 1 and 4-12 are pending in the Application, of which claims 1, 10 and 11 stand rejected (claims 4-9 and 12 have been withdrawn).

Applicant turns now to the art rejection at issue:

35 U.S.C. § 103(a) Rejection - Claims 1-3, 10 and 11 - (Shigetomi et al. in view of Liu et al.)

The Examiner rejected claims 1-3, 10 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shigetomi et al. (U.S. Patent Number 6,287,661; hereinafter "Shigetomi") in view of Liu et al. (U.S. Patent Application Publication Number US 2003/0044559; "Liu"). Applicants respectfully traverse these rejections because the references, either alone or in combination, fail to teach or suggest all of the elements as set forth and arranged in the claims.

Claim 1 sets forth a cover sheet package comprising:

> a thin film cover sheet including a resin film, the thin film cover sheet having an adhesive film formed on one side surface of the resin film, and which is adhered via the adhesive film to a recording surface of a disk substrate of an optical disk;

a peeling sheet which is peelably adhered on a surface of the adhesive film of the cover sheet and which is peeled before the cover sheet is adhered to the recording surface of the disk substrate; and

a protective sheet which is peelably adhered on a surface of the resin film of the cover sheet,

wherein, when an adhesive force for adhering the peeling sheet to the adhesive film of the cover sheet is indicated by AP_1 and an adhesive force for adhering the protective sheet to the resin film of the cover sheet is indicated by AP_2, the peeling sheet is adhered to the adhesive film of the cover sheet and the protective sheet is adhered to the resin film of the cover sheet so that the relationship $AP_1 \leq AP_2$ is satisfied,

wherein the adhesive force AP_1 is set to be a value selected from a range of 5 to 50 (gf/cm), and the adhesive force AP_2 is set to be a value selected from a range of $(AP_1 \times 1.0)$ to $(AP_1 \times 3.0)$, and

wherein a total thickness of the cover sheet, the resin film and the adhesive film is a value in a range from 80 μm to 110 μm" (emphasis added)[1].

Shigetomi in view of Liu fails to teach or suggest every element of the claimed invention as set forth in claim 1. Shigetomi is directed to an information label which is to be placed on an optical disk. The label contains a base sheet, on which data or a display is placed, and an adhesive layer on the base sheet. The adhesive layer is used to adhere the label to the disk. Additionally, a protective film may be placed over the display data on the base sheet (col. 2, lines 55-61), and a release liner can be applied to the surface of the adhesive layer (col. 3, lines 52-53).

The Examiner alleges that Shigetomi discloses a thin film cover sheet which is adhered via adhesive film to a recording surface of a disk substrate of an optical disc, and refers to column 1, lines 6-7 of Shigetomi for this teaching[2]. However, Shigetomi's base sheet only adheres (through an adhesive layer and release layer) to a hard coat layer, which is separate and distinct from a recording layer of an optical disk. Shigetomi's hard coat layer can not be considered as the recording layer in any interpretation of the reference. The Examiner suggests that the claimed "recording surface" is not clearly defined in the specification as to what is contained or covered by the term, and thus alleges that Shigetomi's label and hard coat layer suggests the claimed "recording surface."

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[1] Dependent claims 10 and 11 are patentable over Shigetomi et al in view of Liu et al. by reasons of dependency, as well as for their additionally recited features.

[2] Paragraph 8 on Page 4 of the Office Action dated March 16, 2006.

However, one of ordinary skill in the art of optical disks would be able to clearly understand the claimed "recording surface of a disk substrate of an optical disk" to include recording surfaces as is generally found in the art. It would thus be apparent to one skilled in the art that Shigetomi's hard coat layer cannot possibly be considered as the claimed "recording surface." As described in column 1, lines 15-19 of Shigetomi, the hard coat layer is formed on an aluminum vapor deposition film for protecting the aluminum vapor deposition film, which in turn is formed on a surface of a substrate. Printing of labels is applied directly on the hard coat layer. Thus, Shigetomi's hard coat layer is a protective layer, which is totally separate from the aluminum vapor deposition film which is Shigetomi's recording surface.

Furthermore, the Examiner has also maintained that Shigetomi discloses a protective sheet which is peelably adhered on a surface of the resin film of the cover sheet, and relies on column 2, lines 55-57 of Shigetomi for this teaching[3]. However, Shigetomi is actually silent on any characteristic details of the protect film. There is no teaching or suggestion in Shigetomi of the protect film being either "***peelably*** adhered," or adhered with an adhesive force AP_2 which is greater than or equal to adhesive force AP_1, as recited by claim 1 (emphasis added).

The Examiner has improperly concluded that just because Shigetomi discloses a release liner applied on the surface of the adhesive layer formed on the base sheet of the label, the resultant adhesive force would be required to be less than or equal to an adhesive force binding the protect film to the label. However, because Shigetomi is silent on such a relationship between these two adhesive forces, and also silent on the adhering force of the protect film itself, such a conclusion as made by the Examiner is improper and strictly hindsight, and thus is unsubstantiated by the cited references.

In accordance with an exemplary embodiment of the present invention, the total thickness of the cover sheet, the resin film and the adhesive film is a value in a range from 80 μm to 110 μm, which results in a small bending stiffness. Furthermore, the adhesive force AP_1 of the peeling sheet must be within a range in order to prevent the peeling sheet from being peeled or deviated from the cover sheet when a sheet material is punched or conveyed by a sheet peeling device in a cover sheet package manufacturing process. Therefore, difficulties have been

[3] Paragraph 8 on Page 4 of the Office Action dated March 16, 2006.

encountered for making the bending stiffness of the cover sheet sufficiently larger than the adhesive force AP_1 of the peeling sheet, while also keeping the adhesive force AP_2 for adhering the protective sheet to the cover sheet from becoming excessively large in relation to AP_1 so as to prevent a decrease in workability for peeling the protective sheet from the cover sheet and resultant damage such as deformation on the cover sheet. These difficulties have been successfully navigated by providing a cover sheet package according to exemplary embodiments of the present invention, in which the relationship $AP_1 \leq AP_2$ is satisfied and the adhesive force AP_1 is set to be a value selected from a range of 5 to 50 (gf/cm) as well as the adhesive force AP_2 is set to be a value selected from a range of $(AP_1 \times 1.0)$ to $(AP_1 \times 3.0)$, as recited by claim 1.

Furthermore, Liu does not remedy the deficiencies of Shigetomi, and as such, Shigetomi in view of Liu would not teach or suggest the claimed invention.

In particular, Liu discloses an apparatus which packs and stores recording media by using adhesive coated articles to selectively cause recording media to adhere to a backing surface. Adhesion of recording media to the adhesive coated article is relatively strong (as the recording media is a targeted surface), while adhesion of other materials such as paper to the adhesive coated article is relatively weaker than the adhesion of the recording media.

Although Liu teaches that reading sides of optical discs are secured to the adhesive coated articles, it is only the property of the adhesive which selectively adheres better to a material such as polycarbonate, of which the whole surface of exemplary optical discs are manufactured of. Liu thus fails to disclose or suggest an adherence of a thin film cover sheet via adhesive film *to the disk substrate of an optical disk*, because Liu only discloses adherence of an adhesive coated article to optical discs made of a particular material such as polycarbonate, which the adhesive coating would selectively adhere better to, as opposed to other materials such as paper.

Furthermore, Liu also fails to teach or suggest "a protective sheet which is peelably adhered on a surface of the resin film of the cover sheet," as well as a relationship of adhesive force $AP_1 \leq AP_2$, as recited by claim 1. Although Liu discloses the application of different adhesive forces depending on the material with which the adhesive coated article adheres with, there is no mention or suggestion of the claimed relative relationship between the adhesive force

adhering the peeling sheet to the adhesive film and the adhesive force adhering the protective sheet to the resin film, as recited by claim 1.

In addition, because Liu discloses an adhesive coated article for securing and storing optical discs, while Shigetomi discloses a totally unrelated label for optical disks, there fails to be a proper motivation or suggestion to combine the two references at least because of the variant and divergent manufacturing processes used to create the entirely different types of products (article for securing optical discs versus optical disk labels). Although both Shigetomi and Liu teach adhesives for attaching certain components, these two references are simply not combinable in the manner as suggested by the Examiner. The Examiner's conclusory obtainment of the claimed invention was only derived through the use of improper hindsight.

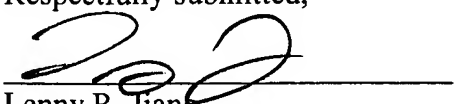
As such, Applicant respectfully submits that Shigetomi in view of Liu fails to teach or suggest the claimed invention as recited by Applicant's claims 1, 10 and 11. The cited references fail to even address the subject of the claimed invention, for which particular relationships and adhesive force values are as recited by claim 1.

For at least any of the above reasons, this rejection is in error. Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 1, 10 and 11 are allowable. Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



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